

PATENT

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Date: 2009-02-06

/Eric Jorgenson, Reg.# 46,002/
Eric D. Jorgenson

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Appellant: Brett J. Buchanan

Examiner: Steven N. Leff

Serial No: 10/752,898

Art Unit: 1761

Filing Date: January 6, 2004

Title: EDIBLE PET TOY

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**AMENDED APPEAL BRIEF IN RESPONSE TO NOTIFICATION OF NON-COMPLIANT
APPEAL BRIEF DATED JANUARY 12, 2009**

Dear Sir:

Appellant submits this amended brief in response to the above Notification to bring the Brief into compliance as requested in the Notification.

I. Real Party in Interest (37 CFR § 41.37(c)(1)(i))

The real party in interest in the present appeal is Brett J. Buchanan, appellant of the present application.

II. Related Appeals and Interferences (37 CFR § 41.37(c)(1)(ii))

Appellant and appellant's legal representatives are not aware of any appeals or interferences which will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims (37 CFR § 41.37(c)(1)(iii))

Claims 1-2, 5-10, 13, 15, 16, 19, 21-23, and 25-27 are pending in the application. Claims 3, 4, 11, 12, 14, 17, 18, 20, and 24 have been cancelled. The rejection of claims 1-2, 5-10, 13, 15, 16, 19, 21-23, and 25-27 is appealed.

IV. Status of Amendments (37 CFR § 41.37(c)(1)(iv))

No claim amendments have been made after the final rejection dated August 6, 2008.

V. Summary of Claimed Subject Matter (37 CFR § 41.37(c)(1)(v))

The subject embodiments relate to an edible toy and method of making the same. The edible toy provides entertainment and nourishment and/or enjoyment to an animal, such as a cat. The edible toy includes a shell 102 that provides oral interaction with the animal (as in independent claim 1). The shell 102 can include an edible material and catnip for stimulation of the cat to interact therewith (as in independent claim 10) for maintaining freshness of underlying material and that gradually wears away as the cat interacts therewith (as in independent claim 19). (See, e.g., FIG. 1 and FIG. 2; page 4, lines 6-11.)

One or more underlying layers 104, 106, 108, 202, 204 formed of an edible material encased by the shell and the toy is edible in its entirety (as in independent claim 1, 10, and 19). The underlying layer(s) can include a layer binding material that provides consistency to retain

form and the edible material includes catnip (as in independent claims 1, 10, and 19). The binding material releases layer materials upon penetration (as in independent claims 1 and 19). (See, e.g., FIG. 1 and FIG. 2; page 4, lines 23-page 6, line 3.)

In the subject embodiments, the edible material is accessed by biting or clawing of the shell by the cat, to expose the underlying layer(s) underneath. The edible material can include an inducement, a nutrient, or a treatment, and can be in the form of a liquid, a gel, a paste, or one or more edible objects. (See, e.g., page 4, line 28 through page 5, line 6.) Multiple underlying layers can provide a plurality of different edible materials, and these multiple layers can be formed concentrically about a core material.

In various aspects, the shell can include an edible nodule or a string affixed thereto. (See, e.g., page 6, lines 6-17; page 7, lines 7-18.) The shell can also include one or more holes for releasing the inner edible material therethrough to the cat. The shell can be flexible such that distortion thereof by the cat causes the inner edible material to be released to the cat. Further, the shell can be compressed to a compression parameter for a particular type of animal such that a lower compression parameter facilitates easier access to the edible material and a higher compression parameter facilitates more difficult access to the edible material. (See, e.g., page 8, lines 14-24.)

An additional aspect relates to a method of providing an edible toy for an animal, and includes providing an edible material and providing a binding material that provides consistency to retain form. Mixing the edible material and binding material is performed to fashion a homogeneous mixture of an inducement and at least one of a nutrient or a treatment. An outer shell is formed for housing the homogenous mixture, and the edible material is encased within the outer shell. (See, e.g., page 10, lines 3-26.) The mixing of the edible material can be performed such that a mixture of edible components exhibits a marbling effect.

In view of the aforementioned aspects, the subject embodiments provide an edible toy that provides a cat with nutrition in addition to enjoyment. Such a device is not evident from the prior art, particularly that relied upon during prosecution.

VI. Grounds of Rejection to be Reviewed on Appeal (37 CFR § 41.37(c)(1)(vi))

- A. Whether claim 5 is unpatentable under 35 U.S.C. § 112, second paragraph.
- B. Whether claims 1-2, 5-10, 13, 19, 21-23, 25, and 27 are unpatentable under 35 U.S.C. § 103(a) over Fisher (U.S. 4,260,635) in view of Smith (U.S. 1,022,113).
- C. Whether claims 1, 2, 5, 10, 13, 15, 16, 21-23, 26, and 27 are unpatentable under 35 U.S.C. § 103(a) over Baikie (U.S. 6,238,715) in view of Smith (U.S. 1,022,113).
- D. Whether the previously-submitted Declaration Under 37 CFR 1.132 is relevant to the issue of nonobviousness.

VII. Argument (37 CFR § 41.37(c)(1)(vii))

- A. Rejection of Claim 5 Under 35 U.S.C. § 112, second paragraph.

Claim 5 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. This issue was raised in the Final Rejection, not in previous prosecution, and is editorial in nature. The language at issue will be corrected upon favorable reconsideration of the rejections under prior art.

- B. Rejection of Claims 1-2, 5-10, 13, 19, 21-23, 25, and 27 Under 35 U.S.C. § 103(a)

Claims 1-2, 5-10, 13, 19, 21-23, 25, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fisher in view of Smith. Reversal of the rejection is respectfully requested for at least the following reasons.

- i. **Fisher and Smith, taken alone or in combination, fail to disclose or suggest each and every element of claims 1, 10, 19, and 21 and claims 2, 5-9, 13, 22-23, 25, and 27, which depend therefrom respectively; therefore, Fisher and Smith do not render unpatentable the present claims to one ordinarily skilled in the art.**
- ii. **The combination of Fisher and Smith is unmotivated and fails to establish a prima facie case of obviousness, as required by 35 U.S.C. §**

103.

The Examiner relies on the structure of Fisher and Smith to reject the subject claims. However, the structure described in Fisher and Smith does not disclose or suggest the structure claimed in the present invention. To establish a prima facie case of obviousness, 35 U.S.C. §103 requires that the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Fisher discloses a pet feeding system for providing food to a dog while providing sufficient exercise for the dog's teeth, gums and jaws, and also having unit-integrity and product "chew life." (See, e.g., col. 4, lines 1-11.) Fisher's pet feeding system includes an outer layer of a high chew-resistance and an inner layer of lesser or no chew-resistance. A number of alternating hard and soft layers *ad infinitum* can be included to meet the chewing demands of a dog. (See, e.g., col. 4, lines 40-50.) The layers are formed from food materials mixed together with safely digestible structure-supporting fibers from animal tissue such as skin, muscles, intestines, etc., from animals, for example from tendons, and animal hides such as cowhide, rawhide, etc. (See, e.g., col. 4, lines 56-60.)

In the aforementioned manner way, Fisher provides an article with food value and chew-resistance to meet the needs of a dog. However, it is evident that the entire disclosure of Fisher relates to the requirements of a *dog* and not those of a *cat*, as is the subject of the presently claimed embodiments. Independent claims 1, 10 and 19 all recite that one or both of the outer shell and edible material include *catnip*, and that claim 21 similarly recites an *inducement*. The Final Action admits that Fisher fails to disclose a toy for a cat and an edible material including catnip. For this purpose, a combination with Smith is proposed who discloses a type of catnip toy. However, this proposed combination is entirely unmotivated. Since the entire disclosure of Fisher relates to a feeding system for a dog that meets the particular chewing needs of a dog, it is readily apparent that such a product cannot be adapted for use with a cat, since it is well known that cats do not have the same teeth and jaw strength capabilities or chewing needs as a dog.

There is no reason why one skilled in the art would seek to combine Fisher's dog feeding and chewing exercise system with Smith's catnip, since such a combination would result in an article that would not be chewable by a cat or a desirable by a dog and thus inoperable for all intents and purposes. Further, it is clear that a considerable amount of engineering and redesigning would be required to adapt Fisher's dog feeding system into an article suitable for chewing and consumption by cats, and that such efforts would go well beyond the disclosure of that reference. Thus, there can be no reasonable expectation of success in accordance with MPEP 2143.02.

The Final Action dismisses these difficulties in asserting the incorporation of Smith's catnip into Fisher's dog-related article, stating that:

...providing a specific single edible material which is known in the art would be merely a matter of obvious choice which is dependent upon the specific animal which the toy is made for, where MPEP 2144.07 states that the selection of a known material based on its suitability for its intended use supports a prima facie obviousness determination. (Final Action, page 4, line 2 up through page 5, line 3.)

This contention is not well taken. Since the entire disclosure of Fisher relates to a food article for a dog, it is readily apparent that any "obvious choice" related to selecting a specific single edible material must be restricted to dogs, since surely there can be no motivation to incorporate catnip into a dog food item! Thus, there is surely no support for a prima facie obviousness determination under MPEP 2144.07 as contended in the Final Action.

It is readily apparent from the aforementioned discussion and from simple common sense that a combination of Fisher and Smith would not occur to one skilled in the art from reviewing these disclosures alone. One skilled in the art would need to be guided by the present disclosure as a 20/20 hindsight road map to the claimed subject matter. Thus, it is respectfully submitted that the proposed combination is unmotivated and thus a prima facie showing of obviousness has not in fact been established against the subject claims, as is clearly required by 35 U.S.C § 103.

Furthermore, even if such a combination could somehow be contemplated, it would still fail to meet all the requirements of the claimed subject matter. Independent claims 1, 10, and 19 each recite an *outer shell* and an *inner edible material* encased by the shell and including a

binding material. Particularly, claim 1 recites an *underlying layer* comprising a *layer binding material* that **releases layer materials upon penetration**. Claim 10 recites that the binding material *provides consistency and rigidity, thereby resulting in a time release of the inner edible material accessible by the cat*. Claim 19 recites that the binding material *provides consistency and rigidity, so as to release inner edible material upon penetration*. In this way, it is clear that the claimed *binding material* and *edible material* are different materials such that the penetration of the binding material results in release of the edible material. However, in rejecting these limitations, the Final Action cites col. 4, lines 1-10. It is readily apparent from inspection that this passage does not include any such disclosure, but rather discusses “unit integrity” of the article while providing chewing exercise to the dog. It is however clear from the disclosure of Fisher that the cowhide and food are formed into a chewable mass that is consumed by the dog such that there is no “release of inner edible material upon penetration” as is recited in the subject claims. Thus, for at least this reason, the Fisher reference, taken alone or in combination with Smith, does not in fact disclose **each and every element** of the subject matter contended in the Final Action, as required by 35 U.S.C § 103.

Additionally, claim 19 recites that the shell *maintains freshness of underlying material and that gradually wears away as the cat interacts therewith*. The Final Action contends that “maintaining freshness” is disclosed by Fisher at col. 4, lines 12-25. However, it is noted that this passage in fact lists a number of food components, indicating that “it is, in general, desirable that said food components have a satisfactory shelf-life so that preservation is no problem.” It is readily apparent that there is no discussion in this passage or elsewhere within the four corners of Fisher of a shell that “maintains freshness of underlying material,” as recited in independent claim 19. The Final Action also contends that “gradual wearing away” is disclosed at col. 1, lines 60-62. However, this passage simply states that chew-resistance is varied with the amount of structure-supporting fibers. Thus, for at least these reasons also, the Fisher reference, taken alone or in combination with Smith, does not in fact disclose **each and every element** of the subject matter contended in the Final Action, as required by 35 U.S.C § 103.

In view of the aforementioned discussion, it is respectfully submitted that Fisher and Smith, taken alone or in combination, fail to disclose or suggest each and every aspect of the claims, and further, that the combination is unmotivated, thus failing to meet the requirements for a prima facie demonstration of obviousness. Accordingly, for least these reasons, it is respectfully requested that this rejection be reversed, and that independent claims 1, 10, 19, and 21 be allowed, along with claims 2, 5-9, 13, 22-23, 25, and 27 that depend respectively therefrom.

C. Rejection of Claims 1, 2, 5, 10, 13, 15, 16, 21-23, 26, and 27 Under 35 U.S.C. § 103(a)

Claims 1, 2, 5, 10, 13, 15, 16, 21-23, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baikie in view of Smith. Reversal of the rejection is respectfully requested for at least the following reasons:

- i. **Baikie and Smith, taken alone or in combination, fail to disclose or suggest each and every element of claims 1, 2, 5, 10, 13, 15, 16, 21-23, 26, and 27, which depend therefrom respectively; therefore, Baikie and Smith do not render unpatentable the present claims to one ordinarily skilled in the art.**
- ii. **The combination of Baikie and Smith is unmotivated and fails to establish a prima facie case of obviousness, as required by 35 U.S.C. § 103.**

The Examiner relies on the structure of Baikie and Smith to reject the subject claims. However, the structure described in Baikie and Smith does not disclose or suggest the structure claimed in the present invention. To establish a prima facie case of obviousness, 35 U.S.C. § 103 requires that the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Baikie discloses a chew toy for dogs including a hollow bone that is cleaned and sterilized and then filled with a filling that includes a meat mixture and a mold inhibitor to prevent the possibility of mold growth on or in the toy. (See, e.g., col. 2, lines 1-64.) It is thus readily apparent that the Baikie reference can only be construed as meeting the needs of a *dog* and not those of a *cat*, as is the subject of the presently claimed embodiments. It is once again noted that independent claims 1, 10 and 19 all recite that one or both of the outer shell and edible material include *catnip*, and that claim 21 similarly recites an *inducement*. The Final Action admits that Baikie is silent with respect to disclosing a toy for a cat and an edible material including catnip. For this purpose, a combination with Smith is once again proposed who discloses a type of catnip toy.

As with the previous rejection, the proposed combination of Baikie and Smith is entirely unmotivated. It is a fact drawn from common experience that dogs chew on bones, not cats, and that cats lack the teeth and jaw strength to chew and penetrate bones as do dogs. Since Baikie's hollow casing is an animal bone, it would defy all logic to suppose that this chew toy would be in any way suitable for a cat. Thus, it would be inexplicable to add catnip according to Smith to the hollow bone of Baikie. Such a combination would result in an article that would not be in any way chewable by a cat or any interest to a dog. Such a combined article would therefore be inoperable for all intents and purposes, and no amount of engineering or redesigning could be contemplated that make a dog bone toy suitable for consumption by cats. Thus, there can be no reasonable expectation of success in accordance with MPEP 2143.02.

The Final Action again dismisses these difficulties in asserting the incorporation of Smith's catnip into Fisher's dog article, again stating that such a combination amounts to merely a matter of obvious choice! The contention is again made that such an obvious choice is dependent upon the specific animal which the toy is made for, again citing MPEP 2144.07 which states that the selection of a known material based on its suitability for its intended use supports a prima facie obviousness determination. However, since a dog is the only specific animal for which this toy can be made, there is no suitability in selecting catnip for a dog bone chew toy. Therefore, based on the very reasoning supplied in the Final Action, there can be no prima facie obviousness determination.

It is again readily apparent from the aforementioned discussion and from simple common sense that a combination of Baikie and Smith would not occur to one skilled in the art from reviewing these disclosures alone, and that such would never occur to one skilled in the art without a hindsight reading of the subject disclosure. Thus, it is respectfully submitted that the proposed combination is unmotivated and that a prima facie showing of obviousness has not in fact been established against the subject claims, as is clearly required by 35 U.S.C § 103.

It is further submitted that, even if such a combination could somehow be contemplated, it would still fail to meet all the requirements of the claimed subject matter. Independent claims 1, 10, and 19 each recite an *outer shell* and an *inner edible material* encased by the shell and including a *binding material*. In particular, claim 1 recites an *underlying layer* comprising a *layer binding material* that ***provides consistency to retain form*** and ***releases layer materials upon penetration***. Claim 10 recites that the binding material ***provides consistency and rigidity, thereby resulting in a time release of the inner edible material accessible by the cat***. Claim 19 recites that the binding material ***provides consistency and rigidity, so as to release inner edible material upon penetration***. In this way, it is clear that the claimed *binding material* and *edible material* are different materials such that the penetration of the binding material results in release of the edible material.

However, in rejecting these limitations, the Final Action cites col. 2, lines 27-31. It is readily apparent from inspection that this passage does not include any such disclosure, but rather discusses that the filling increases interest from the dog as the dog attempts to extract the inside of the bone. There is no discussion of how this result is effected from any binding material. As to limitations of the binding material providing consistency to retain form, col. 2, lines 40-53 is cited which simply discloses steps in forming a premix of various ingredients that form a portion of the filling. A passage at col. 3, lines 16-24 is also cited, but this passage simply discloses cooling steps to change the filling from an aqueous to a gelatin consistency. In any event, it is clear from the disclosure of Baikie that the meat filling is a gelatinous mass and that there is no disclosure of a *binding material* that effects the “release of inner edible material upon penetration” as is recited in the subject claims. Thus, for at least these reasons, the Baikie reference, taken alone or in combination with Smith, does not in fact disclose ***each and every***

element of the subject matter contended in the Final Action, as required by 35 U.S.C § 103.

Additionally, the Final Action variously states that Baikie discloses edible material which is released through one or more holes in the shell, that edible material is encased in a shell, and that edible material can be replaced through a hole in the outer shell, citing a passage from col. 3, lines 6-9 as allegedly disclosing all three of these various aspects. However, this passage actually states:

Bone 20 is then placed adjacent a free end 45 of tube 40, flow valve 42 is adjusted to its open position, and filling 30 is allowed to flow from holding vat 20 into inner region 22 of bone 20.

It is readily apparent that this passage simply discloses a one-time step of adding filling to the hollow bone. There is nothing disclosed or suggested in this passage or elsewhere within the four corners of Baikie about *releasing*, *encasing*, or *replacing* edible material, as recited in the subject claims. It is therefore respectfully submitted that the Final Action misconstrues this passage of the reference in all three instances. Thus, for at least this reason also, the Baikie reference, taken alone or in combination with Smith, does not in fact disclose *each and every element* of the subject matter contended in the Final Action, as required by 35 U.S.C § 103.

In view of the aforementioned discussion, it is respectfully submitted that Fisher and Smith, taken alone or in combination, fail to disclose or suggest each and every aspect of the claims, and further, that the combination is unmotivated, thus failing to meet the requirements for a prima facie demonstration of obviousness. Accordingly, for least these reasons, it is respectfully requested that this rejection be reversed, and that independent claims 1, 10, and 21 be allowed, along with claims 2, 5, 13, 15, 16, 22-23, 26, and 27 that depend respectively therefrom.

D. Holding that the Declaration Under 37 CFR 1.132 is not relevant to the issue of nonobviousness.

The Declaration under 37 CFR 1.132 submitted in response to the Office Action of January 8, 2008 was held to be not relevant to the issue of nonobviousness. Reversal of this holding is respectfully requested for at least the following reasons.

- i. **The Declaration presents evidence of commercial success.**
- ii. **The Declaration presents evidence of long-felt need for the claimed subject matter in the marketplace.**

In an initial remark, the Final Action states:

Regarding applicant's declaration and the testimonials provided which speak to the novelty of the applicant's invention, it is noted that the statement (sic) amount to an *affirmation that the affiant has never seen the claimed subject matter before*. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716. (Emphasis added.)

These statements are baseless and puzzling in that "affiant" is the present appellant who, as the inventor, has surely seen the claimed subject matter before! No detailed explanations are provided as to the reasons why the Declaration is insufficient, as required by MPEP 716, and these statements are therefore merely dismissive of the evidence presented in the Declaration.

The Declaration presents evidence of the commercial success. This issue is not in any way addressed in the Final Action. The claims had been amended to closely comport with the for-sale product so as to be commensurate in scope with the claims, to establish that the commercial success is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and thus establish the nexus between the claimed invention and evidence of commercial success in accordance with MPEP 716.03, 716.03(a), 716.03(b).

To wit, the Declaration states that the product described in the present claims is currently being sold under the trade name "Pawbreakers" (hereinafter "the product"). The product is currently sold in almost every state in the USA and available through the PETCO chain, and is sold abroad through retail locations in Canada, Japan, Taiwan, Malaysia, Hong Kong, Singapore, South Korea, and Poland. This represents significant progress and commercial success for appellant's small business that offers a 100% American-made product. Further evidence of continuing commercial success can be inferred from the various testimonials in the Declaration,

as quoted hereinbelow.

The Declaration also presented evidence of the long-felt need for the claimed subject matter in the marketplace. This evidence in the form of testimonials from veterinarians and well known authorities in the field indicates that for a long period of time there has been a need for a cat toy that engages a cat's attention for a sustained period, and that other products in the field have not met the need as satisfactorily as has been done by the claimed subject matter, in accordance with MPEP 716.04.

For example, a testimonial was received from Franny Syufy, an award-winning member of the Cat Writers' Association, who wrote that, *Brett Buchanan has proven again the old adage that "necessity is the mother of invention" with his Pawbreakers concept*. Franny's testimonial indicates that appellant has solved the problem of containing catnip in a manner satisfying to cats. Franny notes that, *Pawbreakers were the result of countless hours of experimenting and testing on enthusiastic cats, until exactly the right shape and size was attained*, thereby observing other overall benefits and desirable properties of the claimed subject matter.

In another testimonial, Dr. Elizabeth Devitt, a writer for *PET AGE* magazine, observes that *Pawbreakers combine domestically grown catnip with a hypoallergenic binder into a long-lasting toy that cats actually can consume*, thereby acknowledging the innovative aspects of and the desirable results obtained from the claimed subject matter. In a further testimonial, Pam Johnson-Bennett, CABC, a well-known and popular expert on cat behavior, indicates that the claimed subject matter *could be a valuable tool for behavior modification* and that she would *like more behaviorists and other professionals to know about it*.

The testimonial evidence indicates that the actual structure of the claimed subject matter provides solutions to long-noted problems in the areas of catnip toy manufacture and cat behavior modification. However, the Final Action is also dismissive of this evidence. Further, the Final Action states that:

[T]here is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem.

With regards to the prior art rejections in the Final Action, it is respectfully submitted that this statement is without basis. The Final Action relies on dog bone articles in combination with catnip, shown hereinabove to be unmotivated and failing to disclose each and every aspect of the claimed subject matter. It is further noted that the Office Action of January 8, 2008 that preceded the Final Action relied upon a similarly unlikely combination of cat toy articles.

For at least these reasons, it is again respectfully submitted that one skilled in the art would not overcome the aforementioned problems in the art from these references or any of the other feeble combinations of references offered throughout the prolonged prosecution of the present application. Accordingly, for least these reasons, it is respectfully submitted that the rebuttal evidence of nonobviousness does in fact outweigh the alleged evidence of obviousness, and a notice to that effect is earnestly solicited.

Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited reference. Accordingly, it is respectfully requested that the rejections of claims 1-2, 5-10, 13, 15, 16, 19, 21-23, and 25-27 be reversed.

In the event any additional fees may be due, the Commissioner is authorized to charge the fees or credit any overpayments to Deposit Account No. 50-3663 [BBUCP101USA]

Respectfully submitted,

/Eric Jorgenson, Reg.# 46,002/

Eric D. Jorgenson
Reg. No. 46,002

Law Office of Eric D. Jorgenson, Esq.
1457 King Road
Hinckley, Ohio 44233
Telephone (216) 225-4169
Facsimile (330) 278-3135

VIII. Appendix of Claims (37 CFR § 41.37(c)(1)(viii))

1. An edible toy for an animal, comprising:
a shell for oral interaction with the animal; and
at least one underlying layer formed of an edible material encased by the shell,
the toy is edible in its entirety;
wherein the at least one underlying layer comprises a layer binding material that provides consistency to retain form, the binding material releases layer materials upon penetration, and the edible material including catnip.
2. The toy of claim 1, wherein the edible material comprises at least one of an inducement, a nutrient, or a treatment.
5. The toy of claim 1, wherein the edible material is accessed by at least one of the cat biting the shell or clawing the shell.
6. The toy of claim 1, wherein the at least one underlying layer comprises multiple layers of a plurality of different edible materials.
7. The toy of claim 6, wherein the multiple layers are formed concentrically about a core material.
8. The toy of claim 1, wherein the shell includes at least one of an edible nodule or a string affixed thereto.
9. The toy of claim 1, wherein the shell is compressed to a compression parameter for a particular animal such that a lower compression parameter facilitates easier access to the edible material and a higher compression parameter facilitates more difficult access to the edible material.

10. An edible toy for a cat, comprising:
an outside shell for oral interaction with the cat, the shell comprises an edible material and catnip for stimulation of the cat to interact therewith; and
an inner edible material encased by the shell, the inner edible material comprises a binding material that provides consistency and rigidity, thereby resulting in a time release of the inner edible material accessible by the cat, the inner edible material made of edible components and catnip, wherein the entire toy is of edible material and thereby edible in its entirety.
13. The toy of claim 12, wherein the inner edible material is in the form of at least one of a liquid, a gel, a paste, or one or more edible objects.
15. The toy of claim 10, wherein the shell includes one or more holes for releasing the inner edible material therethrough to the cat.
16. The toy of claim 10, wherein the shell is flexible such that distortion thereof by the cat causes the inner edible material to be released to the cat.
19. An edible toy for a cat, comprising:
a shell for interaction by the cat, the shell made of an edible material that includes catnip, maintains freshness of underlying material and that gradually wears away as the cat interacts therewith; and
an inner edible material that is the underlying material and which is encased by the shell and accessible by the cat over an extended period of time, wherein the shell and inner edible material include an edible binding material that provides consistency and rigidity, so as to release inner edible material upon penetration, such that the toy is composed of edible material in its entirety.

21. A method of providing an edible toy for an animal, comprising:
providing an edible material;
providing a binding material that provides consistency to retain form;
mixing the edible material and binding material into a homogeneous mixture of
an inducement and at least one of a nutrient or a treatment;
forming an outer shell for housing the homogenous mixture; and
encasing the edible material within the outer shell.
22. The method of claim 21, wherein the edible material includes an inducement that stimulates the animal, which is a cat, to interact therewith.
23. The method of claim 22, further comprising compressing the shell and the edible material to a compression parameter that allows the cat to access the edible material via at least one of licking, biting, or clawing.
25. The method of claim 21, further comprising mixing the edible material such that a mixture of edible components thereof exhibit a marbling effect.
26. The method of claim 21, further comprising forming a hole in the outer shell such that the edible material can be replaced therethrough.
27. The method of claim 21, wherein the outer shell comprises the edible material.

IX. Appendix of Evidence (37 CFR § 41.37(c)(1)(ix))

Appended herewith on the following pages 20-25 is a copy of a Declaration Under 37 CFR 1.132 that presents testimonial evidence in support of appellants position. The Declaration was submitted on May 2, 2008 in accompaniment with a Reply to the Office Action of January 8, 2008.

PAGE 14/20 * RCVD AT 5/2/2008 10:58:11 AM [Eastern Daylight Time] * SVR:USPTO-EFXXRF-5/3 * DNIS:27283300 * CSID:330 278 3135 * DURATION (mm:ss):04:26

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Date: 5/2/08

Eric D. Jorgensen
Eric D. Jorgensen

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): **Brett J. Buchanan**

Serial No: **10/752,898**

Filing Date: **January 6, 2004**

Examiner: **Steven N. Leff**

Art Unit: **1761**

Title: **EDIBLE PET TOY**

**Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

DECLARATION UNDER 37 CFR 1.132

Brett J. Buchanan hereby declares that:

1) I am the inventor of EDIBLE PET TOY, as described in the above-identified U.S. patent application.

2) I am the owner of E.A.T.'s - Edible Animal Treats of Monroe, Michigan, a company doing business since June, 2003, that provides edible products for animals, particularly house cats.

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3) The product described in the above-referenced patent application and the appended claims relates to an edible toy for an animal having a shell for oral interaction with the animal and one or more underlying layers formed of an edible material encased by the shell. One or more of the underlying layers include a layer binding material that provides consistency to retain form. The binding material releases layer materials upon penetration. The edible material includes catnip and the toy is edible in its entirety.

4) The product as described in the above-referenced patent application and commensurate with the appended claims is currently being sold under the trade name "Pawbreakers." This product is enjoying ever-increasing levels of commercial success, and has been well received in the pet products marketplace. Also, this product has met a long-felt need in the pet products marketplace, as evidenced by the testimonials that have been received from expert authorities in the pet field, as presented hereinbelow.

5) A testimonial was received from Franny Syufy, who has written about cats for About.com since 1997. Franny is a member of the Cat Writers' Association, an organization of prominent cat writers, photographers, artists, and broadcasters. She won awards from CWA for her writing in 2003, 2004, and 2005, including the prestigious Purina One Health Award for her article, *When to Call Your Veterinarian for Your Cat*. In 2005, Franny was honored with the Muse Medallion in CWA's online magazine competition. She is currently working on a book about cats that will be published in spring 2009. Franny writes:

Brett Buchanan has proven again the old adage that "necessity is the mother of invention" with his Pawbreakers concept. Like most cat lovers, he provided his three cats with plenty of catnip toys, but noticed that as his kitties aged, their interest waned. As he reasoned, "Would you like to smell your favorite food but never be able to eat it?" Next, he provided dry catnip in a bowl for his cats to snack on. As cats will do, they'd dive into the bowl and soon all the catnip would be scattered over the surrounding carpet, and out would come the vacuum, while the cats were still unsatisfied.

Pawbreakers were the result of countless hours of experimenting and testing on enthusiastic cats, until exactly the right shape and size was attained. My cats were no exception to the excitement with which cats greet their first

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introduction to Pawbreakers. Each of them got his own Pawbreaker, and it was hilarious fun watching them chase their toy-treats around the floor, then nuzzle and love them before licking them to death.

It wasn't long before all the Pawbreakers had disappeared - either completely consumed or lost under our sectional furniture. Put a couple of the toy-treats in a dry bathtub and watch your cat's antics as the ball rolls up and down the sides, or try Pawbreakers with the Peek-a-Prize toy box (see sidebar for review). My four test cats give Pawbreakers four paws up, and I give them a "5" for combining snacktime with playtime for cats.

6) Another testimonial was received from Dr. Elizabeth Devitt, a freelance writer specializing in animal health-care topics for *PET AGE* magazine. In an email, Dr. Devitt stated, "I love the whole idea of your product." The following is an excerpt from an article in the March, 2008 issue of *PET AGE* magazine, entitled *Re-Inventing Catnip*.

But let's not forget the ever-popular catnip, which is surfacing in a variety of novel treat forms.

For example, Pawbreakers from Edible Animal Treats (Monroe, Mich.) are toys as well as consumable treats. Voted most innovative product by *Cat Fancy* in 2005, Pawbreakers combine domestically grown catnip with a hypoallergenic binder into a long-lasting toy that cats actually can consume.

Brett Buchanan, owner of Edible Animal Treats, says he created Pawbreakers because he was tired of seeing his cats turn away from toys after a short time. "After almost two years, my cat was still batting his Pawbreakers around," Buchanan said.

7) The following testimonial information about Pawbreakers was recently provided in answer to a series of questions by Pam Johnson-Bennett, CABC, of Cat Behavior Associates in Nashville, Tennessee. Pam Johnson-Bennett is one of America's most well-known and popular experts on cat behavior. In addition to running a private veterinarian-referral behavior service, Pam is the resident cat behavior expert at Yahoo.com. She also makes numerous national television appearances including Fox News Channel, CNN and National Geographic, as well as being a popular guest on many nationally syndicated radio programs. She is the author of seven titles, including *Cat vs. Cat*, *Think Like a Cat*, *Hiss & Tell*, and *Starting From Scratch*. Pam is the behavior spokesperson for Friskies. She is also

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on the Advisory Board for Tree House Animal Foundation. Pam is Vice President of the International Association of Animal Behavior Consultants and Founder/Chair of the cat division. Pam asked the following questions, and user testimonials are included with the replies are provided thereafter:

1) *What have veterinarians and/or behaviorists had to say specifically about the product?*

I'm a veterinarian with the goal of becoming board certified in feline behavior. I think this product has a great deal of potential as environmental enrichment for cats, but I noticed something else as well. One of my cats is currently undergoing chemo and radiation therapy for a vaccination sarcoma (cancer). His appetite has been diminished lately, but after each play session with the Pawbreaker, he goes over and munches on cat food for a while. I noticed a definite difference in his attitude and appetite. -- Dr. Florsheim in Texas

I wanted to let you know I received the sample Pawbreakers and literature. As with some of your own customer comments, my oldest cat got into my mail bag and started smelling and poking at the box until she got it out and knocked it onto the floor. Then the other cat joined in. They both enjoyed them. I've looked at your website and have copied the stores where they are available here in Massachusetts so I can refer my clients in my behavioral practice to them. You've created the perfect toy/treat. -- Dr. Bette Armstrong

2) *Have you had any feedback from customers or professionals who found the product helped with any behavior problems? -- not just positive comments that they liked the product, but specific information about the benefits for addressing behavior issues such as separation anxiety, depression, compulsive behavior, fear, etc.*

Being kitty people yourself you know that cats can be very finicky about everything. My one kitty I found in a parking lot and he had trouble adjusting to a life indoors with people who care. He wouldn't play with any toys I introduced to him and would shy away from any physical contact. However, the one toy he absolutely could not pass up is your catnip balls! He goes crazy! Now he plays and loves all kinds of attention. My other kitty also goes nuts over them and she is as finicky as they come! I always have to make sure they each have their own or a fight will surely break out. Crazy felines. -- T. Hartwick

I ordered some just a couple of weeks ago and had them shipped to my Moins for Christmas...I was at Mom's over the weekend and her cat and mine were

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squabbling, so I broke out the Pawbreakers and gave them each one. All was forgiven as both cats went nuts...will need some more as I plan on shipping a couple off to friends with their Christmas presents...and I sure don't want to run out here at home! - D. Sharples

My cats, Dari & Alex, have recently discovered the joys of Pawbreaker heaven..... Thank you SO MUCH for making this wonderfully entertaining product! These gentlemen, both 15 years old, have "never" expressed an interest in ANY particular toy, or in catnip at all, until I found Pawbreakers" - R. Wilken

Statistics:

The following statistics were compiled from hundreds of product testers in the USA and worldwide before introducing Pawbreakers to the public.

- 1) 9 out of 10 testers had positive reactions to the product
- 2) 8 out of 10 cats reacted immediately
- 3) 7 out of 10 cats played with this toy more than any other toy.

ever!

3) *What is the availability of the product overall? What are the future plans for availability? -- The reason I ask this is that I don't include product information in my books if the product has very limited availability.*

We hope to have Pawbreakers available to customers around the world....currently we are in almost every state in the USA and growing rapidly (many locations have not been updated on our website, sorry...that should happen soon). Customers can order anytime on the web at www.pawbreakers.com. shipping is included in the USA, Canada and Mexico....or, they can also find them at their local PETCO:

We also ship directly to customers around the world and we have retail locations in Canada, Japan, Taiwan, Malaysia, Hong Kong, Singapore, South Korea, Poland and other locations around the world.

Please also note that Pawbreakers are also a 100% USA made product!

Pam Johnson-Bennett replied with the following statement:

I think the idea of your product is outstanding and if it performs as claimed on your website, it could be a valuable tool for behavior modification and I'd like more behaviorists and other professionals to know about it.

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8) I believe that all statements made herein of my knowledge are true, and believe that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements and the like so made may jeopardize the validity of the application or any patent issuing therefrom.

DECLARANT:

Date: May 1, 2008


Brett J. Buchanan

X. Related Proceedings Appendix (37 CFR § 41.37(c)(1)(x))

(None)